

**REMARKS**

This is in response to the initial Office Action mailed July 3, 2002, in relation to the above-identified patent application. In that initial Office Action, the Examiner rejected Claims 1-24 under 35 U.S.C. Section 103(a) as being unpatentable over DAY et. al. in view of NELSON.

Independent Claims 1, 11 and 18 have been amended to more clearly point out the unobvious structure of the present invention and clearly distinguish the same over the prior art. In particular, Independent Claim 1 has been amended to include the added limitations "...wherein said insert is fully enclosed at a distal end to form a splash protective canopy portion, and wherein said insert provides an opening at a proximal end for ease of accessibility to the interior of the splash pan." Support for this amendment can be found in the illustration of Figure 5, and on page 6, lines 8 – 15, and page 7, lines 20, 21. It is respectfully submitted that none of the cited references, taken either alone or in combination with one another, either disclose or make obvious a disposable barrier that has these features. Further, Independent Claims 11 and 18 have been amended to include the limitation of Dependent Claims 12 and 19, respectively. Accordingly, Independent Claims 11 and 18 now require a "reservoir formed within said base [or disposable tray]." None of the cited references taken either alone or in combination with one another, either disclose or make obvious a disposable barrier having a reservoir. Dependent Claims 12 and 19 have been deleted, and Dependent claims 13 – 17, 20 – 24 have been amended consistent therewith. Accordingly, Claims 1-11, 13-18, and 20-24 remain pending.

The DAY patent reference (United States Patent No. 3,249,070), the principal reference cited by the Examiner in the initial Office Action for the patent application, discloses the use of a "soft disposable paper" adapted to be insertible in a substantially flat instrument tray. It appears that the Examiner acknowledges that the DAY reference is lacking the teaching of the "rigid" limitation. Accordingly, NELSON is cited as providing this element.

The NELSON patent reference (United States Patent No. 3,430,803), a secondary reference cited by the Examiner in his initial Office Action for the patent application, discloses the use of a rigid disposable food tray insert formed contiguous with a substantially flat tray-like base member for use as an insulated food tray.

Applicant believes that the Examiner's hypothetical combination of the DAY and NELSON patent references represent a hindsight reconstruction of the subject invention and as such further constitutes an improper combination of prior art references. In re Shaffer; 108 USPQ 328 (CCPA 1956); and Bolyard v. Watson, Com'r, 124 USPQ 165 (DC Dist. Col. 1960).

Indeed, the NELSON patent reference is from an altogether divergent field from that of the DAY patent reference and does not disclose any type of dental or medical application whatsoever. Applicant does not believe that one would look to the food industry when trying to provide an improved protective barrier for vulnerable and containable surfaces in a medical environment. The design of a disposable food tray is a comparatively simple task having few constraints as compared to the more complex issues involved in designing specially fitted barriers for preventing contamination between medical instruments and equipment used with multiple patients. As such, one of ordinary skill in the medical barrier art would not expect to

learn from the food tray art anything useful about how to build effective disposable barriers for instrument trays or dental splash pans in a manner which prevents cross contamination.

Even if NELSON were to be combined with DAY, it is still void of any teaching or suggestion of a disposable insert being “fully enclosed at a distal end to form a splash protective canopy portion, and wherein said insert provides an opening at a proximal end for ease of accessibility to the interior of the splash pan,” as set forth in newly amended Independent Claim 1. DAY only suggests a protective cover for use on the surface of the substantially flat “receiver portion” of a “tray.” See Col. 1, lines 20 – 22. The English language definition of a “tray” is “an open variously shaped receptacle with a flat bottom and a low rim for holding, carrying or exhibiting articles.” *Webster's Third International Dictionary (1993)*. The “receiver portion” is the flat bottom of the tray as further defined in DAY at col. 2, lines 1 – 3. Clearly, DAY does not disclose or make obvious a disposable insert being “fully enclosed at a distal end to form a splash protective canopy portion, and wherein said insert provides an opening at a proximal end for ease of accessibility to the interior of the splash pan,” as set forth in newly amended independent claim 1. Further, it would not be possible to utilize the non-rigid sheet material as taught in DAY to come up with the configuration as set forth in applicants claimed invention.

As with DAY, the invention in NELSON is directed to a “disposable tray,” having a “horizontal bottom and an upwardly and outwardly extending lip.” Col. 1, lines 39 – 42. Any suggestion that the references be so modified as to provide the device as recited in newly amended Independent Claim 1 simply cannot be supported. As noted in *In re Gordon*, 773 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), the mere fact that the prior art could be so modified

would not have made the modification obvious unless the prior art suggested the desirability of the modification. See also, *Karl Schnek, A.G. v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 702 (Fed. Cir. 1983); *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983).

Finally, with respect to amended independent claims 11 and 18, the Examiner has cited no prior art which would suggest or make obvious a "reservoir formed within said base [or disposable tray]."

### CONCLUSION

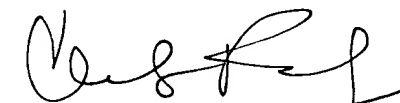
In view of the foregoing it is respectfully submitted that all of the pending apparatus claims of the present invention have been amended to particularly define the unobvious structure of the present invention. It is respectfully submitted, that, as amended, all of the pending claims of the subject patent application are in condition for immediate allowance. A reconsideration and allowance is therefore respectfully requested.

Respectfully submitted,

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Dated:

SEPT 18, 2002



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**VERSION WITH MARKINGS TO SHOW CHANGES MADE  
IN THE CLAIMS:**

Delete claims 12 and 19.

1. (Amended) A disposable barrier for a laboratory splash pan comprising:  
a non-porous rigid, disposable insert having the general shape of  
the inside surface of a laboratory splash pan, wherein said insert is fully enclosed at a  
distal end to form a splash protective canopy portion, and wherein said insert provides an  
opening at a proximal end for ease of accessibility to the interior of splash pan.

11. (Amended) A disposable barrier for a laboratory splash pan comprising:  
a non-porous, rigid, disposable base having elevated sides so as  
to form a recessed tray; and

a reservoir formed within said base for retention of a substance.

18. (Amended) A method for protecting the interior surface of a splash pan,  
comprising:

seating a non-porous, rigid, disposable tray within a splash pan; and  
integrally forming a reservoir within said disposably tray.

23. (Amended) The method of claim [19] 18 further comprising securing a  
substance within said reservoir by means of a removable cover.

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